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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,163	09/29/2003	Michael A. Rothman	42PI7574	5557

7590 05/10/2007
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EXAMINER

BROWN, MICHAEL J

ART UNIT	PAPER NUMBER
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2116

MAIL DATE	DELIVERY MODE
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05/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/675,163	Applicant(s) ROTHMAN ET AL.	
	Examiner Michael J. Brown	Art Unit 2116	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 28, 36, and 44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Each of the claims includes the limitation "no additional software" which is considered new matter.
2. Claims 28, 36, and 44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Because the "no new matter" limitation is not presented in the specification and is new matter there is no description of how to make and/or use the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 28-51 are rejected under 35 U.S.C. 102(b) as being anticipated by DeRosa et al.(US Patent 5,822,565).

The following rejection with respect to DeRosa remains the same from previous rejection(Non-Final Rejection, 11/14/2006) due to amended claims consisting of new matter. Examiner is examining case without the amended new matter.

As to claim 28, DeRosa discloses a method comprising determining if a computer(computer system 10, see Fig. 1) can read a block of data(configuration utility 20, see Fig. 1) on a medium(main memory 16, see Fig. 1) coupled with the computer during a pre-boot phase(see column 1, lines 28-31), and in a case where the computer cannot read the block of data, reading a header on the medium that describes a location of a program(underlying system software 22, see Fig. 1) on the medium, the program to enable the computer to read the block of data(see column 5, lines 43-46), and loading the program in the computer(see column 4, lines 35-38).

As to claim 29, DeRosa discloses the method wherein the program is a file system driver(see column 5, lines 54-62).

As to claim 30, DeRosa discloses the method wherein the file system driver is to operate in accordance with the Extensible Firmware Interface (EFI) framework standard(see column 8, lines 49-51).

As to claim 31, DeRosa discloses the method further comprising mounting a file system using the file system driver, and reading the data using the file system(see column 4, lines 53-61).

As to claim 32, DeRosa discloses the method wherein the program is a pre-boot recovery utility(see column 4, lines 32-38).

As to claim 33, DeRosa discloses the method wherein the pre-boot recovery utility is an Extensible Firmware Interface (EFI) application(see column 8, lines 49-51).

As to claim 34, DeRosa discloses the method further comprising recovering a storage device coupled with the computer by reading a portion of the block of data and writing the portion to the storage device using the pre-boot recovery utility(see column 4, lines 35-38).

As to claim 35, DeRosa discloses the method further comprising recovering a corrupted operating system boot target stored on the storage device using the pre-boot recovery utility, wherein the medium includes a magnetic backup tape(see column 4, lines 35-38).

As to claim 36, DeRosa discloses an article of manufacture comprising a first machine-readable medium(disk drive 12, see Fig. 1) including a plurality of instructions(machine instructions, see column 4, lines 33-34) which when executed perform operations comprising determining if a computer(computer system 10, see Fig. 1) can read a block of data(configuration utility 20, see Fig. 1) on a second machine readable medium(main memory 16, see Fig. 1) coupled with the computer during a pre-boot phase(see column 1, lines 28-31). DeRosa also discloses that in a case where the

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computer cannot read the block of data, reading a header on the second medium that describes a location of a program(underlying system software 22, see Fig. 1) on the second medium, the program to enable the computer to read the block of data(see column 5, lines 43-46), and loading the program in the computer(see column 4, lines 35-38).

As to claim 37, DeRosa discloses the article of manufacture wherein the program is a file system driver(see column 5, lines 54-62).

As to claim 38, DeRosa discloses the article of manufacture wherein the file system driver is to operate in accordance with the Extensible Firmware Interface (EFI) framework standard(see column 8, lines 49-51).

As to claim 39, DeRosa discloses the article of manufacture wherein execution of the plurality of instructions further perform operations comprising mounting a file system using the file system driver, and reading the data using the file system(see column 4, lines 53-61).

As to claim 40, DeRosa discloses the article of manufacture wherein the program is a pre-boot recovery utility(see column 4, lines 32-38).

As to claim 41, DeRosa discloses the article of manufacture wherein the pre-boot recovery utility is an Extensible Firmware Interface (EFI) application(see column 8, lines 49-51).

As to claim 42, DeRosa discloses the article of manufacture wherein execution of the plurality of instructions further perform operations comprising recovering a storage device coupled with the computer by reading a portion of the block of data and writing

the portion to the storage device using the pre-boot recovery utility(see column 4, lines 35-38).

As to claim 43, DeRosa discloses the article of manufacture further comprising recovering a corrupted operating system boot target stored on the storage device using the pre-boot recovery utility, wherein the second medium includes a magnetic backup tape(see column 4, lines 35-38).

As to claim 44, DeRosa discloses a computer system(computer system 10, see Fig. 1), comprising a processor (CPU 11, see Fig. 1) and at least one non-volatile storage device(disk drive 12, see Fig. 1) operatively coupled to the processor. DeRosa also discloses that the at least one non-volatile storage device including firmware instructions(machine instructions, see column 4, lines 33-34) which when executed by the processor perform operations comprising determining if the computer can read a block of data(configuration utility 20, see Fig. 1) on a medium(main memory 16, see Fig. 1) coupled with the computer during a pre-boot phase(see column 1, lines 28-31). DeRosa further discloses that in a case where the computer cannot read the block of data, reading a header on the medium that describes a location of a program(underlying system software 22, see Fig. 1) on the medium, the program to enable the computer to read the block of data(see column 5, lines 43-46), and loading the program in the computer(see column 4, lines 35-38).

As to claim 45, DeRosa discloses the system wherein the program is a file system driver(see column 5, lines 54-62).

As to claim 46, DeRosa discloses the system wherein the file system driver is to operate in accordance with the Extensible Firmware Interface (EFI) framework standard(see column 8, lines 49-51).

As to claim 47, DeRosa discloses the system wherein execution of the firmware instructions further perform operations comprising mounting a file system using the file system driver, and reading the data using the file system(see column 4, lines 53-61).

As to claim 48, DeRosa discloses the system wherein the program is a pre-boot recovery utility(see column 4, lines 32-38).

As to claim 49, DeRosa discloses the system wherein the pre-boot recovery utility is an Extensible Firmware Interface (EFI) application(see column 8, lines 49-51).

As to claim 50, DeRosa discloses the system further comprising recovering a storage device coupled with the computer by reading a portion of the block of data and writing the portion to the storage device using the pre-boot recovery utility(see column 4, lines 35-38).

As to claim 51, DeRosa discloses the system further comprising recovering a corrupted operating system boot target stored on the storage device using the pre-boot recovery utility, wherein the medium includes a magnetic backup tape(see column 4, lines 35-38).

Response to Arguments

3. Applicant's arguments filed 2/15/2007 have been fully considered but they are not persuasive. Applicant's arguments on based on the amended limitation of "using

firmware but no additional software". Since the amended limitation is new matter the rejection remains the same and arguments are moot.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

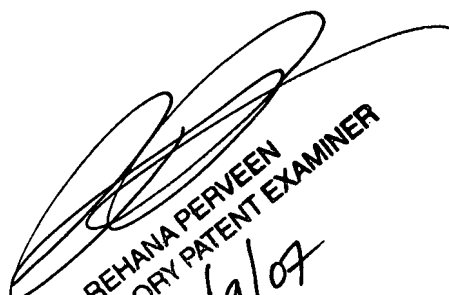
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Brown whose telephone number is (571)272-5932. The examiner can normally be reached Monday-Thursday from 7:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rehana Perveen can be reached on (571)272-3676. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael J. Brown
Art Unit 2116


REHANA PERVEEN
SUPERVISORY PATENT EXAMINER
5/9/07